



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO.          | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|---------------------|------------------|
| 10/803,631               | 03/18/2004  | Blaine H. Dolph      | AUS920040046US1     | 5810             |
| 37945                    | 7590        | 11/18/2010           |                     |                  |
| DUKE W. YEE              |             |                      |                     |                  |
| YEE AND ASSOCIATES, P.C. |             |                      |                     |                  |
| P.O. BOX 802333          |             |                      |                     |                  |
| DALLAS, TX 75380         |             |                      |                     |                  |
| EXAMINER                 |             |                      |                     |                  |
| TEKLE, DANIEL T          |             |                      |                     |                  |
| ART UNIT                 |             | PAPER NUMBER         |                     |                  |
| 2481                     |             |                      |                     |                  |
| NOTIFICATION DATE        |             | DELIVERY MODE        |                     |                  |
| 11/18/2010               |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

# Office Action Summary

**Application No.**

10/803,631

**Applicant(s)**

DOLPH, BLAINE H.

**Examiner**

DANIEL TEKLE

**Art Unit**

2481

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Argument*

Applicant's arguments with respect to claim 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-22 rejected under 35 U.S.C. 102(b) as being anticipated by Koga (US 2001/0042018).

**Regarding Claim 1:** Koga discloses a method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) comprising: sending, by a processor of a service provider (**paragraph 0040: user terminal 40 receives the program containing the advertisement program from the broadcasting station system 30 to display them on the display screen**), a television program containing the original marketing content from the service provider to a DVR (**paragraph 0040: user terminal 40 receives the program containing the advertisement program from the broadcasting station system 30 to display them on the display screen**); receiving, by the processor, a user ID and a program ID from the DVR (**paragraph 0041: transmits the user ID to the service system 50 through the network 100**). **Also, the user terminal 40 transmits the multifunction icon ID to the user terminal**

**40. Thus, the service system 50 can recognize the guide menu program or multifunction icon stored in the user terminal; paragraph 0043: the user terminal 40 transmits an ID of the selected menu item and the user ID to the service system 50 through the network 100) and responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID (paragraph 0061: user previously carries out free charge use registration of the customer data such as the address, name and birthday of the user to a service provision company, and the service system 50; paragraph 0058: user personal information), and sending by the processor, a local marketing content to the DVR (paragraph 0066: broadcasting station system 30 carries out the broadcasting delivery through the satellite 60, the program produced by the broadcasting station together with the advertisement program for sales promotion received from the advertising agency system 20 (Step A7). At this time, the advertisement program for sales promotion is displayed on the display screen of the user terminal 40 as shown in FIG. 4), wherein the local marketing content is based on the location of the user and the program ID (paragraph 0061: user previously carries out free charge use registration of the customer data such as the address, name and birthday of the user to a service provision company, and the service system 50; paragraph 0058: user personal information).**

**Regarding Claim 2:** Koga discloses a method of claim 1 further comprising:  
determining whether no local marketing content exists for the television program

**(paragraph 0056: service system 50 provides the user through the network 100 with service such as an e-mail function of free communication charge through the network 100); and responsive to a determination that the no local marketing content exists for the television program, sending a message indicating that no local marketing content exists for the television program to the DVR (paragraph 0056: service system 50 provides the user through the network 100 with service such as an e-mail function of free communication charge through the network 100).**

**Regarding Claim 3:** Koga discloses a method of claim 1, further Freeman et al. discloses wherein the local marketing content is add-on marketing content **(paragraph 0066 and Figure 4: advertisement comment area and Figure 5: list of outline of articles).**

**Regarding Claim 4:** Koga discloses a method of claim 1, further Freeman et al. discloses wherein the local marketing content is a replacement marketing content **(paragraph 0068 and Figure 4: selection multi-function icon).**

**Regarding Claim 5:** Koga discloses a method of claim 1 the local marketing content is an overlay marketing content **(paragraph 0068 and Figure 4: selection multi-function icon).**

**Regarding Claim 6:** Claim 6 reject for the same reason to claim 1 as discussed above.

**Regarding Claim 8:** Koga discloses a method of claim 7, wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile associated with the user ID **(paragraph 0061: user previously carries out free charge use registration of the customer data such as the address, name and**

**birthday of the user to a service provision company, and the service system 50; paragraph 0058: user personal information; also refer to claim 1 as discussed above regarding user ID and program ID).**

**Regarding Claims 7, 9-11:** Claims 7 and 9-11 reject for the same reason to claims 2-5 respectively as discussed above.

**Regarding Claims 12-22:** Claims 12-22 reject for the same reason to claim 1-11 respectively as discussed above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 2481

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel Tekle/  
Examiner, Art Unit 2481

/Peter-Anthony Pappas/  
Supervisory Patent Examiner, Art Unit 2481